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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,326	03/16/2001	Jon L. Cook	08049.0006	5362
22852	7590	01/08/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER SALLARD, SHANNON S	
			ART UNIT	PAPER NUMBER
			3628	
			MAIL DATE	DELIVERY MODE
			01/08/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/809,326

Applicant(s)

COOK ET AL.

Examiner

SHANNON S. SALIARD

Art Unit

3628

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-16, 54-59, 89-90, 96-97, and 101-104 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 5/27/08

DETAILED ACTION

Status of Claims

1. Applicant has amended claims 11, 14, 15, 54, 57, 58, 89, 90, 96, and 97. Claims 1-10, 17-53, 60-88, 91-95, and 98-100 have been cancelled. Claims 101-104 have been newly added. Thus, claims 11-16, 54-59, 89, 90, 96, 97, and 101-104 remain pending and are presented for examination.

Response to Arguments

2. Applicant's arguments filed 02 October 2008, with respect to the rejections of claims 13 and 56 under 35 U.S.C. 112, Second Paragraph, have been fully considered and are persuasive. The rejections of claims 13 and 56 under 35 U.S.C. 112, Second Paragraph has been withdrawn.

3. Applicant's arguments filed 02 October 2008, with respect to the rejection(s) of claim(s) 11, 14, 54, 57, 89, 90, 96, and 97 under 35 U.S.C. 103 (a), have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Winslow [US 7,236,970].

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 54-59, 103, and 104** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 54-59, 103, and 104 purport to be directed toward a system, however the bodies of the claims recite only logic or software for a computer. Thus, the claims are directed to functional descriptive material that is not functionally or structurally interrelated to any medium. Data structures not claimed as embodied on statutory computer readable media (i.e., storage media, and excluding non-statutory media such as carrier waves) are descriptive material *per se* and therefore not patentable subject matter under § 101 as they are neither a process, a machine, a manufacture, nor a composition of matter. MPEP § 2106 IV.(g)(1)(a).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 11-16, 54-59, 89, 90, 96, 97, and 10-104** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanevsky et al [US 6,285,777] in view of Winslow [US 7,236,970].

As per **claims 11, 14, 54, 57, 89, 90, 96, and 97**, Kanevsky et al discloses a method for determining a standardized physical address of a user with an electronic account of the user, comprising the steps of [col 6, lines 29-34]:

Creating a database containing a standardized physical address of the user a standardized physical address conforms to a standard format [col 5, line 49-col 6, line 8; see fig. 5 and descriptions thereof];

obtaining an address of the user from the electronic account [col 5, lines 44-49];
sending the address of the user to the static address database [col 5, lines 55-59]. Kanevsky et al does not explicitly disclose receiving a delivery point identification key corresponding to the address of the user, wherein the delivery point identification key can be used to obtain the standardized physical address of the user from the static address database. However, Kanevsky et al discloses that a header contains identifying information to determine a corresponding address associated with a register e-mail address for use in mailing an item [col 6, lines 29-34; col 2, lines 59-62; col 3, lines 16-24; Examiner interprets key to be any info for determining address]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Kanevsky et al to include receiving a delivery point identification key corresponding to the address of the user, wherein the delivery point identification key can be used to obtain the standardized physical address of the user from the static address database to determine how to handle the mail as suggested by Kanevsky et al [col 2, lines 55-65].

Kanevsky et al does not disclose creating a static address database from a master address database, the static address database containing the standardized physical address of the user. However, Winslow discloses creating a static address database from a master address database [col 1, lines 46-56]. It would have been

obvious to one of ordinary skill in the art to include in the addressing system of Kanevsky et al the ability to create a static address database from a master address database as taught by Winslow since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claims 12 and 55**, Kanevsky et al does not disclose wherein the master address database is a United States Postal Service master address database. However, Winslow discloses wherein the master address database is a United States Postal Service master address database [col 1, lines 46-56]. It would have been obvious to one of ordinary skill in the art to include in the addressing system of Kanevsky et al wherein the master address database is a United States Postal Service master address database as taught by Winslow since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claims 13 and 56**, Kanevsky et al further discloses wherein the static address database is a United States Postal Service static monolithic address database [col 3, lines 59-61].

As per **claims 15 and 58**, Kanevsky et al further discloses wherein the address database contains a plurality of standardized addresses corresponding to a plurality of users, each standardized address conforming to a standard format [col 6, lines 1-4].

As per **claims 16 and 59**, Kanevsky et al further discloses wherein the standard format includes a street and city [see Fig. 5]. Kanevsky et al does not disclose wherein the standard format includes street number, street name, city, state, and ZIP code. However, it is old and well known at the time of the invention that a standard address of a user contains street number, street name, city, state, and ZIP code. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Kanevsky et al to include wherein the standard format includes street number, street name, city, state, and ZIP code to facilitate mail identification.

As per **claims 101-104**, Kanevsky et al does not further disclose wherein the standard format of the standardized physical address comprises one of "delivery point", "plus 4", "5 digit", and "last line" standardization. However, the Examiner takes Official Notice that it is old and well known in the art at the time of the invention for a physical address to include at least one of "delivery point", "plus 4", "5 digit", and "last line". Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Kanevsky et al to include wherein the standard format includes at least one of "delivery point", "plus 4", "5 digit", and "last line" to facilitate mail identification.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHANNON S. SALIARD whose telephone number is

(571)272-5587. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Hand delivered responses should be brought to the Customer Service Window,
Randolph Building, 401 Dulany Street, Alexandria, VA 22314

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